REMARKS

Applicants appreciate the continuing detailed examination evidenced by the Office Action mailed August 18, 2004.

Claims 1, 2, 6, 8-9, 13, 14, and 16-24 have been amended to eliminate recitations of "means for" in the computer program product claims. Claims 55, 56, 60, 62, 63, 67, 68, and 70-78 have been amended to eliminate recitations of "step" in the method claims.

The sole ground of rejection of these claims is a provisional statutory double patenting rejection of Claims 1, 28, and 55 under 35 U.S.C. §101 as claiming the same invention as that of Claims 1, 22, and 43 of copending U.S. Patent Application No. 09/422,430 ("the '430 application"), and under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 28, and 55 of copending U.S. Patent Application No. 09/422,492 ("the '492 application") and Claims 1, 22, and 43 of copending U.S. Patent Application No. 09/422,431 ("the '431 application").

Applicants' Amendment Filed in the '430 Application Overcomes the Provisional Statutory Type Double Patenting Rejection of Claims 1, 28, and 55:

In an Amendment filed on August 27, 2004 in the '430 application, Applicants amended Claims 1, 22, and 43 therein. Applicants note that the August 27, 2004 amendment in the '430 application was filed after the Office Action was mailed in the present application. Applicants respectfully submit that the statutory type double patenting rejection of Claims 1, 28, and 55 of the present application has been overcome by the amendments to Claims 1, 22, and 43 in the '430 application.

Applicants note that with respect to the double patenting rejections based on 35 U.S.C. § 101, M.P.E.P. § 804 provides:

> A reliable test for double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent [or related pending patent application]. *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there were such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

Amended Claim 1 of the present application recites:

> computer-readable program code that is configured to create an output document in which each element of said interim transient document for which markup notation has been added is encrypted in a manner that **enables a clerk process associated with a group that is a community member** authorized to view that element to use key distribution material associated with the output document when decrypting the encrypted element.

In contrast, amended Claim 1 of the '430 application recites:

> computer-readable program code for creating an output document in which each element of said interim transient document for which markup notation has been added is encrypted in a manner that **enables each community member** that is authorized to view that element to use key distribution material associated with the output document to decrypt the encrypted element, and that precludes decryption of the encrypted element by unauthorized community members. (Emphasis added.)

Although the "clerk process" recited in Claim 1 of the present application may be a "community member", which is a term recited in Claim 1 of the '430 application, it is a special type of community member that is authorized to decrypt encrypted elements of the output document. Moreover, Claim 1 of the present application does not recite the underlined portion shown above from Claim 1 of the '430 application.

Accordingly, Applicants respectfully submit that Claim 1 of the present application is not claiming identical subject matter as recited by Claim 1 of the '430 application. Moreover, Claim 1 of the present application may be literally infringed without literally infringing Claim 1 of the '430 application. Under the test provided by M.P.E.P. § 804, identical subject matter is not defined by both claims and statutory double patenting does not exist. Accordingly, Applicants respectfully request withdrawal of the provisional statutory double patenting rejection of Claim 1 of the present application.

Independent Claims 22 and 43 of the '430 application were amended to contain similar recitations as amended Claim 1 of the '430 application, and are respectfully submitted to not claim identical subject matter as Claims 28 and 55 of the present application for the reasons explained above for Claim 1. Accordingly, Applicants respectfully request

withdrawal of the provisional statutory double patenting rejection of Claim 1 of the present application.

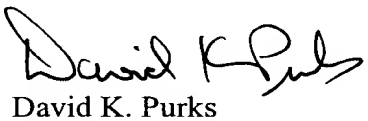
Applicants File Herewith a Terminal Disclaimer to Overcome the Provisional Obviousness-Type Double Patenting Rejection of Claims 1, 28, and 55:

Applicants submit herewith a Terminal Disclaimer disclaiming additional term over the copending '492 application and the '431 application. Applicants' agreement to provide a Terminal Disclaimer is to expedite issuance of the present case and does not admit that the present invention is obvious in light of the copending '492 application or the '431 application. Withdrawal of the obviousness-type double patenting rejection is respectfully requested.

CONCLUSION

In light of the above amendments and remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested.

Respectfully submitted,



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